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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,067	08/20/2001	Steve Brandstetter	P/94-1	6703

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/933,067	BRANDSTETTER ET AL.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-13,16 and 18-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11-13,16 and 18-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 August 2007* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. Applicant appears to have attempted to submit amendments to the drawings showing a bin & a computer system with a website. Examiner objects to these drawings because they do not meet the standards required for patent drawings. They are of very poor quality. Furthermore, Fig 5 appears to be a screen print showing a computer – not only is it illegible; it does not describe the claimed invention. (A line drawing of the website would be more to the point.)

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figs 4 & 5 are not tied into the specification. For instance, there is a discussion in the specification about putting tickets in a bin. This part of the specification should be amended to refer to bin (50). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-6, 9, 12, & 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz (US Patent Number 6,585,589) in view of Quinn (US Patent Number 3,688,276).

Claim 1: Okuniewicz teaches device for paying out a bonus (Col 1, 43-46) to a player playing a gaming machine. (Fig 1) There is a gaming machine (Slot Machine). The gaming machine obviously contains a processor for implementing a game of chance (including video poker) and paying off according to matching symbols. (Col 1, 20) There is a dispensing unit (Lottery Terminal). Since Okuniewicz teaches that the dispensing unit may dispense a ticket when a preset amount of coins are inserted (Col 3, 46-53), there must be a numeric counter for counting the number of coins placed in said gaming machine that counts coins until a ticket is generated. Okuniewicz does not teach visually displaying to the player the number of coins needed to generate a ticket or the number of coins inserted by the player. Nor does Okuniewicz teach resetting the counted coins to zero once a ticket is generated. These are common functions on virtually any modern vending machine.

Quinn, which is also a lottery ticket dispenser, teaches visually displaying to the player the number of coins needed to generate a ticket and the number of coins inserted

by the player as well as resetting the counted coins to zero once a ticket is generated. (Fig 1) Such a visible meter allows the player to know how much money he must insert and how much money he has inserted. Clearing the counter lets the player know that if he wants another ticket, he has to put in more money. These features add to user convenience and are, as previously pointed out, extremely well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz in view of Quinn to visually display to the player the number of coins needed to generate a ticket and the number of coins inserted by the player as well as to reset the counted coins to zero once a ticket is generated in order to add to player convenience.

Furthermore, a combination of prior art elements, each performing their normal functions in a predictable manner to yield a predictable result is obvious. In this case, Okuniewicz teaches a slot machine that dispenses a lottery ticket when a preset number of coins have been inserted into the machine. Quinn, which also dispenses a lottery ticket when a preset number of coins have been inserted into the machine, has a meter that displays the number of coins inserted and the number of coins remaining prior to dispensing a ticket. In the combination, Okuniewicz's slot machine/ticket dispenser works in its accustomed manner. Quinn's lottery ticket dispenser/coin meter work in it's accustomed manner. The combination of Okuniewicz and Quinn yield predictable results. The combination is therefore obvious.

Claims 2-4: Okuniewicz teaches that the dispensing unit may be a retrofit unit for a slot machine (Col 3, 1-4). Okuniewicz teaches that the dispensing unit could be attached to

the gaming machine externally (i.e., side-mounted) or mounted internally. (Col 4, 63-66)

Claim 5: The gaming machine may include video poker machines (Col 3, 36-42). Video bingo games and video keno games are disclosed as equivalents.

Claim 6: The dispensing unit is a self-contained unit that does not affect play or outcome of said gaming machine. (Col 4, 35-43)

Claim 9: Okuniewicz dispenses lottery tickets. (Abstract)

Claim 12: Claim 12 is a combination of claims 1, 5, & 9 with the addition of holding a drawing to determine a winner of said ticket – which is taught by Okuniewicz.

Claim 16: Okuniewicz teaches the lottery ticket may be for the Big Game. In the Big Game, a bonus prize is generated from a percentage of total coins placed into all participating gaming machines (i.e., a percentage of money used to buy game tickets).

Claim 17: Claim 17 is a subset of claim 1.

Claim 19: It is extremely well known to. This practice has been followed in raffles and lotteries across the country (and probably around the world) for decades if not centuries. Applicant cannot even begin to imagine that he has invented this method of conducting a lottery. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz & Quinn to include placing the entrant's name & address on a ticket & place the ticket in a bin for drawing in order to adopt an ***extremely*** old and well known method of conducting a lottery.

3. Claims 7, 8, 11, 13 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz and Quinn as applied to claim 1, 12 above, and further in view of Castellano et al. (US Patent Number 5,477952).

Claims 7, 13: Okuniewicz and Quinn teach the invention substantially as claimed. Both contain coin counters, but do not give details of the operation thereof. Okuniewicz bonuses a player based on number of coins played (Col 3, 51) but does not teach that the numeric counter counts coin pulses off of the gaming machine's hard meter. Castellano teaches the method of operation of the coin counters. Castellano teaches that the numeric counter (12) counts coin pulses off of the gaming machine's hard meter (52). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz and Quinn in view of Castellano to have the numeric counter count coin pulses off of the gaming machine's hard meter in order to carry out Okuniewicz and Quinn's suggestion to count the coins entered by the player.

Claim 8: Okuniewicz and Quinn teach the invention substantially as claimed. Neither specifically discloses that the numeric counter can count various coin denominations. Castellano specifically teaches discloses that the numeric counter can count various coin denominations. (Fig 1, 21-24) Allowing players to use more than one denomination makes it convenient for the player to put more money in the slot machine. This increases profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz and Quinn in view of Castellano to have the numeric counter can count various coin denominations in order to make it convenient for the player to put more money in the slot machine.

Claims 11, 18: Okuniewicz teaches that the benefit of the device is the ability to change the criteria for generating a ticket. (Col 3, 1-9) The LIB is a remote unit (i.e., a separate module) for changing the number of coins necessary to generate said ticket.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz & Quinn as applied to claim 20 and further in view of http://www.powerball.com.

Claim 20: Okuniewicz & Quinn teach the invention substantially as claimed, but fail to teach announcing the lottery results on a website. This is extremely well known in the art. The Powerball lottery results have been announced on a website since at least 28 January 1998. (See http://web.archive.org/wbe/19980128120719/www.musl.com/scripts/html.pl?powerball.ptm) Announcing the results of a lottery on a website provides a cost effective means of disseminating the results. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz & Quinn in view of http://www.powerball.com to announce the lottery results on a website in order to have a cost effective way to disseminate the results.

Response to Arguments

3. Applicant's arguments filed 21 August 2007 have been fully considered but they are not persuasive.

4. Applicant argues that neither reference alone teaches the claimed invention. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well known that allowing the customer to see how many additional coins need to be placed in a machine prior to vending increases player convenience. Furthermore, in the *KSR* decision, the Court made it clear that the TSM test was no longer the only test for obviousness.

6. Applicant states that, ""If the person plays the gaming machine enough, i.e., a random amount of times according to Okuniewicz, a ticket may be generated at some random point." This completely ignores the absolutely crystal clear disclosure in Okuniewicz that the machine may be set to issue a ticket when a certain number of coins are inserted. (Col 3, 46-53) This has been explained to Applicant a number of times. Deliberate mischaracterization of the reference does not change the teachings of the reference, nor does it advance prosecution of the case. In the hope (perhaps vain) of putting this line of argument to rest once and for all, Examiner will quote the pertinent section from Okuniewicz:

> In the preferred embodiment, a standard electronic gaming device such as a slot machine or video slot machine would be used as the base unit for the implementation of the present invention, and examples of the events which might trigger the dispensing of a lottery ticket would include the hitting of a specific reel combination, ***a preset amount of coin in***, a certain level of game play, or any other detectable electronic device event or series of events. (Emphasis added.)

This cannot be any clearer. Okuniewicz teaches that (in one embodiment), if a player puts in a preset number of coins (i.e., a preset amount of coin in), the machine will dispense a

lottery ticket. This is ***precisely*** what Applicant's invention does. The only difference between Okuniewicz's invention and Applicant's is a coin meter. Quinn provides the coin meter.

Should Applicant continue with the case, Examiner urges Applicant to address the embodiment of Okuniewicz's invention that dispenses a lottery ticket upon the insertion of a preset number of coins and not alternate embodiments that have nothing to do with this Office Action or any of the previous Office Actions. As pointed out above, refusal to discuss the pertinent embodiment of Okuniewicz's invention does not change what Okuniewicz teaches, nor does it advance prosecution.

Conclusion

7. This is an RCE of applicant's earlier Application No. 09/933,067. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however,

event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Applicant merely added previously rejected limitations into another claim & rehashed arguments that have been answered repeatedly (See at least Office Actions of 21 February 2007, 25 May 2006 & 12 December 2005). Therefore, Applicant's filing cannot be said to have been a bona fide attempt to advance prosecution of the case.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/
Primary Examiner
Art Unit 3714

Gaming Device Bonusing System

Field of the Invention

A gaming system which pays out a bonus to a player playing a gaming machine.

Background of the Invention

US Patent 5,810,664 relates to an electronic gaming apparatus which preferably corresponds to and effectively automates games of chance, for example, the game known as the "pull-tab". The apparatus is generally played by a single player and is designed to dispense a ticket containing indicia thereon. A large number of tickets are in the apparatus and the player actuates the apparatus and obtains a dispensed ticket. If the indicia which appears on the ticket constitutes winning or scoring indicia, the player obtains a reward. All tickets are preprinted and may be dispensed from a bin containing pre-cut tickets. Otherwise, the tickets may be severed from a strip in the form of a roll containing all of the tickets sequentially. The apparatus comprises a display means which displays each of the indicia on a ticket. The display is operated in a manner so that the indicia are effectively scrolled across the display screen to generate an image of rotating wheels which display the indicia. A method of distributing pre-printed rolls of tickets is provided such that each player of the gaming apparatus plays against every other player and not just the gaming apparatus.

US Patent 4,652,998 relates to a video gaming system with pool prize structures including remote game terminals and a central controller with two-way communications between the remote game terminals and the central controller. Prize awards are based upon random shuffling of a set of prize awards among a predetermined pool of plays for each remote game terminal. This ensures an equal distribution of prize awards to each

CORBETT B. COBURN
PRIMARY EXAMINER